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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,771	11/21/2000	Koji Hayashi	10449-028001	9013

7590

06/06/2002

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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 06/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

HK

Office Action Summary

Application No.

09/717,771

Applicant(s)

HAYASHI, KOJI

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: _____

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DETAILED ACTION

Applicant's and communication and amendment of 3/15 2002 has been considered with the following results.

Information Disclosure Statement

The IDS of 3/15/2002 has been made of record.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1, 2, and 7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed ability of control the recording operation by way of a controller for the laser source, does not reasonably provide enablement for all controllers. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Applicants' attention is drawn to *In re Hyatt, 218 USPQ 195*. This is a single means rejection.

Response to Arguments

Applicant's arguments filed 3/15/02 have been fully considered but they are not persuasive. Applicant has amended the above indicated claims to include a to laser drive circuit, which is then controlled by the appropriate in the interrupt circuit. The examiner considers the addition of this laser drive circuit has been a nominal recitation of an element that is necessary and hands and no additional information/limitation with respect to the interrupt circuit. Hence the examiner maintains this rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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2. Claims 1- 9 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. The existence/recognition/detection of the "relatively low level" is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

As argued in applicant's latest communication, this relatively low power level is essential and critical to applicant's invention. Nevertheless, there is no element to detect or recognize the existence of such a condition. Hence interpreting the independent claims requiring such a limitation, either such a limitations inherently follows from the elements positively recited or have not been properly positively presented by any of the limitations presently found in the independent claims. Since the claims are understandable under 35 USC 1/12 paragraph 2, he examiner determines that these claims fail under 35 USC paragraph 1, e.g. the critical feature is not claimed. Furthermore, with respect to the phrase relatively low level, because no such level has been define, or what power levels are to be included in such a limitation, the examiner makes the following ^{act} ~~base~~ rejections.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 7- 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamasaki et al further in consideration of either Official notice or Yoshikawa.

With regard to the independent claims, applicant's attention is drawn to the primary reference of Yamasaki et al, noting in particular the abstract and the description of figure 1. The examiner ascertains there is a laser power control element 8, which inherently drives the laser appropriately. This is under control of a system depicted and his elements 6, 20, and 19 and furthermore under operation of an

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abnormality condition. The examiner interprets such condition to include such well-known system failures including such as recited in the independent claims of a relatively low power level. Such relatively low power levels of a laser can occur when; a laser ceases to operate or when a laser operates outside of its normal condition. Such system failures are considered inherently present in the Yamasaki et al system.

Alternatively, if applicant can convince the examiner that such relatively low power level is not present in the Yamasaki system, then the examiner would rely upon the additional feature found in the secondary reference to Yoshikawa, see the operation of the controlled circuit indicated has element for, and 6 in this document. Such would be obvious to use in the primary reference to prevent a miswrite operation of the system.

With respect to the dependent claim limitations, since sync single patterns are inherently present in the information provided to the laser beam for recording, the examiner also interprets such limitations as inherently present in the Yamasaki reference.

With regards to the synchronizing and restarting limitations of claims 3 and 9 the examiner also consider such limitations as inherently present in the primary reference. Absent such capabilities there would be no ability to continue writing the information upon the optical disk after the process suspended.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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4. Claims 3-8 and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over JP document 10-063433 considered with either Yoshikawa, or Koishi et al, or Takasugi.

As far as the examiner can ascertain from the abstract, the system posses a control device, element 8 in figure 3, and as recited upon resume the information commences from the interrupt position. The examiner concludes therefore that the elements to store the address location, and sync. operations are inherently present.

Although there is no clear recitation in the abstract with respect to relatively low power level, any of the secondary references teach in this environment the ability of a low power level of the laser and such is considered an abnormal operating condition.

It would have been obvious to one of ordinary skill in the art to modify the base system with the teachings from any of the secondary reference is, either Koishi et al ('548 or '462) or Takasugi, or Yoshikawa in order to provide for the interrupt capability predicated upon a relatively low power level and correct for any miswrite condition/operation.

With respect to the limitations of claims 4 & 5, the formats are considered present. The underrun capability is interpreted as the limitation of claim 6. The method limitations of claims 8 and 9 are met when the above system operates.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 3 above, and further in view of Bakx, or any of the secondary references cited on the IDS of March 15th 2002.

With regards to the limitation of claim 6, such an ability is recognized in this environment has taught by any of these secondary references.

It would have been obvious to one of ordinary skill in the art to not fall he the base system as analyzed and stated in paragraph 3, with the above teachings from the secondary references to controlled memory buffer ability and hands prevent any loss of information.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple

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assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 3, 7, 8 and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,4, 12 and 13 respectively of copending Application No. 09/717772 in view of Bakx. and either of the Koishi et al ('548/ '462) references or Takasugi or Yoshikawa.

The reasons for presenting the double patenting rejection as cited in the previous office action, are amended to include the additional relatively low power level teaching found in any of the above noted secondary references to either Koishi et al or Takasugi or Yoshikawa.

Response to Arguments

Applicant's arguments with respect to claims 3 and 9 have been considered but are moot in view of the new ground(s) of rejection.

This is a provisional obviousness-type double patenting rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sasaki et al, Takeuchi et al, Numata et al, Yamanaka et al.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH**

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shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Korzuch can be reached on (703) 305- 6137. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.


Aristotelis M Psitos
Primary Examiner
Art Unit 2651

AMP
June 2, 2002